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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/671,833	09/27/2000	Peter J. Brittenham	5577-210	5914
20792	7590	06/03/2004	EXAMINER	
MYERS BIGEL SIBLEY & SAJOVEC			DINH, MINH	
PO BOX 37428			ART UNIT	
RALEIGH, NC 27627			PAPER NUMBER	

2132

DATE MAILED: 06/03/2004

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/671,833

Applicant(s)

BRITTENHAM ET AL.

Examiner

Minh Dinh

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-49 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-49 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 9/27/2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

1. Claims 1-49 have been examined.

Claim Objections

2. Claims 3 and 24-25 objected to because of the following informalities:
 - a. Regarding claim 3, change "ones of" (2nd line) to "one of".
 - b. Regarding claims 24-25, the dependency of the claims are not consistent with those of corresponding method claims, claims 5-6, and corresponding system claims 39-40. Claim 24 is interpreted as dependent claim of claim 21 and claim 25 is interpreted as dependent claim of claim 22.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 3, 22, 24 and 37 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
 - a. Regarding claims 3, 22 and 37, it is not clear what the limitation "the step of selectively linking ones of the selected generic definitions to further define ..." means. The claims do not recite with which one of the selected generic definitions is linked.

b. Regarding claim 24, it recites the limitation "the plurality of generic definitions" in the first and second lines. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless – (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1-5, 20-24 and 35-39 are rejected under 35 U.S.C. 102(e) as being anticipated by Tushie et al. (6,202,155).

a. Regarding claims 1, which is representative of claims 20 and 35, Tushie discloses a method comprising the steps of:

providing a plurality of generic definitions, at least a portion of which have a predefined relationship to others of the generic definitions so as to provide a hierarchy of generic definitions (col. 5, lines 38-41 and figures 3-4);

selecting generic definitions from the plurality of generic definitions to associate the selected generic definitions with an instance of a card product definition, the instance of a card product definition defining characteristics of the smart card product (col. 6, lines 26-36);

populating the selected generic definitions with data associated with the smart card product so as to provide a hierarchy of instances of the generic definitions which define the characteristics of the smart card product (col. 10, lines 12-15).

b. Regarding claims 2, 21 and 36, Tushie further discloses the steps of registration of card product holders and managing smart card product personalization utilizing the hierarchy of instances of the generic definitions, so as to provide the smart card product having the defined characteristics (figures 6A, 6B).

c. Regarding claims 3, 22 and 37, the limitation "the step of selectively linking ones of the selected generic definitions" is interpreted as "the step of selectively linking some of the selected generic definitions to other selected definitions" (see page 66, lines 24-26). Tushie further discloses selectively linking some of the selected generic definitions to other selected definitions (col. 7, lines 16-22).

d. Regarding claims 4, 23 and 38, Tushie further discloses process definitions which define smart card management tasks which are configured to manage the attributes of the smart card product (fig. 4).

e. Regarding claims 5, 24 and 39, Tushie further discloses a chip definition (col. 11, lines 60-64) and a card holder definition (col. 8, lines 21-23).

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

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invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 6-15, 25-34 and 40-49 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tushie. The claims are directed to methods for establishing an instance of the card product definition and associating other definitions with the instance of the card product definition for managing the card product. Tushie discloses a method for establishing an instance of the card product definition and associating other definitions with the instance of the card product definition for managing the card product (figures 3 and 4). Although the reference does not specifically disclose all the claim limitations regarding certain definitions associated with the instance of the card product definition, Tushie teaches that the instance of the card product definition is not limited to only the definitions that are disclosed (col. 6, lines 31-32). This provides a clear suggestion that other types of definitions can be added according to each system design. Therefore, using other types of definitions as claimed would be obvious to one having ordinary skill in the art.

9. Claims 16-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tushie in view of Williams (6,735,593) and Graham, Jr. et al. (6,402,028).

a. Regarding claim 16, Tushie discloses a system comprising smart card definitions, wherein the smart card definitions are associated in a hierarchical manner so as to encapsulate characteristics of smart card components, interrelationships with other components, work processes.

Tushie does not disclose that the definitions are stored in a database. Williams discloses a database for storing entities with complex relationships between them (see Abstract). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Tushie to store the smart card definitions in a database, as taught by Williams, in order to possibly reuse application with different databases, merge database easily, and store data about a wide variety of items without restraints inherent in the relational model (col. 2, lines 30-33).

Tushie does not disclose a smart card server operably associated with the database and configured so as to manage smart card products based on instances of the smart card definitions associated with the smart card products. Graham discloses a smart card server operably associated with a smart card database and configured so as to manage smart card products based on instances of the smart card definitions associated with the smart card products (fig. 13, elements 1310, 1318). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Tushie to include a smart card server operably associated with a smart card database and configured so as to manage smart card products based on instances of the smart card definitions associated with the smart card products, as taught by Graham, so that post-issuance loading of applications onto a smart card product could be done over a network (col. 22, lines 50-57).

b. Regarding claim 17, Tushie does not specifically disclose the claim limitations regarding enterprises and connection definitions. However, Tushie teaches that the instance of the card product definition is not limited to only the definitions that are

disclosed (col. 6, lines 31-32). This provides a clear suggestion that other types of definitions can be added according to each system design. Therefore, using other types of definitions as claimed would be obvious to one having ordinary skill in the art.

c. Regarding claim 18, Tushie does not disclose an application manager server. Graham discloses an application manager server (fig. 13, element 1310) configured to manage applications loaded on the smart card products based on the smart card definition of applications associated with a smart card product (col. 9, lines 23-33 and fig. 14). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of claim 16 to include an application manager server configured to manage applications loaded on a smart card product based on smart card definitions associated with the smart card product, as taught by Graham, so that post-issuance loading of applications onto a smart card product could be done over a network (col. 22, lines 54-57).

10. Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Tushie in view of Williams and Graham as applied to claim 16 above, and further in view of Eigeles (6,401,203). Tushie, Williams and Graham do not disclose a certificate server configured to manage certificates utilized with a smart card product based on smart card definitions associated with the smart card product. Eigeles discloses a certificate server configured to manage certificates utilized with a smart card product (col. 2, lines 4-6; col. 4, lines 41-42). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of claim 16 to include a certificate

server configured to manage certificates utilized with a smart card product, as taught by Eigeles, and accordingly, the smart card definitions include definitions providing information needed to manage the certificates. The motivation for doing so would have been to use the Certificate Authority to address authentication problems (col. 2, lines 3-6).

Conclusion

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Bublitz et al. (5,684,742) disclose a device and method for the simplified generation of tools for the initialization and personalization of a smart card.

Agarwal et al., "An Operational Approach to the Design of Workflow Systems".

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Minh Dinh whose telephone number is 703-306-5617. The examiner can normally be reached on Mon - Fri: 9:00 am - 5:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gilberto Barron can be reached on 703-305-1830. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MD

Minh Dinh
Examiner
Art Unit 2132

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5/28/2004



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